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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Protest Filed Under 37 CFR 1.291(a)

#12

First Named Inventor:	James D. Schlick	Assignee: Kepner-Tregoe, Inc.
Appl. No.:	09/493,783 unknown - claims priority of US Provisional applications 60/091,476, filed July 2, 1998, entitled ELECTRONIC TOOL, and 60/133,746, filed May 12, 1999, entitled ELECTRONIC TOOL	RECEIVED AUG 01 2001 Technology Center 2100
Filed:	unknown	Examiner: Kyle Choi
Title:	unknown - Believed to be: Method and Apparatus For Problem Solving, Decision Making, Storing, Analyzing, Retrieving Enterprise Wide Knowledge and Conclusive Data	Group Art Unit: 2163

Transmittal Letter

Assistant Commissioner for Patents
Attention: Office of Petitions
Crystal Park 1, Room 520
Washington, D.C. 20231

I hereby certify that this document is being sent via
First Class U. S. mail addressed to: Assistant
Commissioner for Patents, Washington, D.C. 20231
on this 23rd day of July, 2001.

James D. Schlick
(Name)

Dear Sir:

Enclosed for filing in the above application are the following:

1. Communication regarding Protest filed under 37 CFR 1.291(a);
- 1864 2. Protest filed under 37 CFR 1.291(a), explaining the relevance of the items listed on PTO-1449 form;
3. PTO-1449 form, submitted in duplicate, listing the references discussed in the Protest;
4. A copy of each reference listed on the PTO-1449 form; and
5. Certificate of Service of the Protest upon Applicant in accordance with 37 CFR 1.248.
6. PCT application PCT/US99/15049

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It is believed that no fee is due in connection with this communication. However, the Office is hereby authorized to charge Deposit Account 04-1420 for any fees due. A copy of this transmittal letter is enclosed for this purpose.

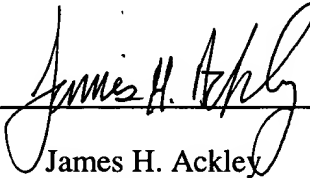
Please direct all correspondence to the undersigned.

Respectfully submitted,

Date:

July 23, 2001

By



James H. Ackley
Registration No. 45,695
Dorsey & Whitney
220 South Sixth Street
Minneapolis, Minnesota 55402
Telephone: 612/340-6381



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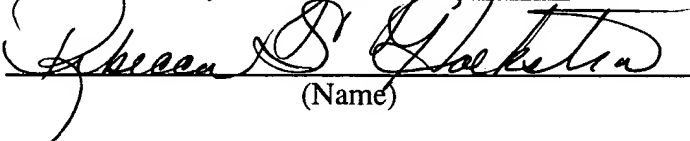
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Communication regarding Protest filed under 37 CFR 1.291(a)

Assistant Commissioner for Patents
Attention: Office of Petitions
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Washington, D.C. 20231

I hereby certify that this document is being sent via First Class U. S. mail addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on this 23rd day of July, 2001.


(Name)

Dear Sir:

Protestor is filing a Protest for a US non-provisional application filed by James D. Schlick, assigned to Kepner-Tregoe, Inc., which claims priority of US provisional applications 60/091,476, filed July 2, 1998, entitled ELECTRONIC TOOL, and 60/133,746, filed May 12, 1999, entitled ELECTRONIC TOOL. Protestor contacted the Patent Office Help Desk and was informed that the application was in front of Examiner Kyle Choi in Group Art Unit 2163. Protestor called the Examiner, and was advised that Protestor should file a protest.

It is Protestor's belief that the above-identified application includes claims 1-3 equivalent to claims 1-3 in published PCT application PCT/US99/15049, published on January 13, 2000. It

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is this belief which forms the basis for Protestor's assertion that the enclosed publication will make the claims unpatentable.

In Kepner-Tregoe, Inc. v. Executive Development, Inc., Civ. No. 97-CV-3473 (D N.J.), the court held on December 13, 1999 that Executive Development's materials did not infringe copyrights of Kepner-Tregoe. The court records evidence that the references enclosed in this protest were in possession of Kepner-Tregoe, who it is believed is an Assignee of the US application being protested. See Kepner-Tregoe, Inc. v. Executive Development, Inc., Civ. No. 97-CV-3473 (D. N.J. 1999), p. 4 of App. 0006. For this reason, these references should have been disclosed under 37 CFR 1.56. 37 CFR 1.56 states, in part, "Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section." It is not known whether Applicant or Applicant's attorney has put these references into the possession of the Examiner for consideration and review. However, in view of PCT application PCT/US99/15049, Protestor submits the enclosed references to ensure that no patent is granted for material that was publicly known before the date of invention by the Applicant.

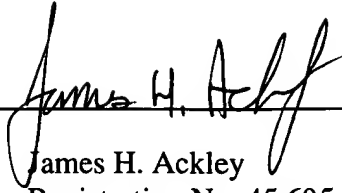
Protestor believes it has complied with the requirements of MPEP Section 1900, and requests that the protest be filed for the application to which it refers. Protestor requests that if there is insufficient information to locate the correct application, or if Protestor has not fully complied with all of the requirements under MPEP Section 1900, that the Patent Office contact the undersigned as soon as possible to correct the deficiency. Please direct all correspondence to the undersigned.

Respectfully submitted,

Date:

July 23, 2001

By



James H. Ackley

Registration No. 45,695

Dorsey & Whitney

220 South Sixth Street

Minneapolis, Minnesota 55402

Telephone: 612/340-6381



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Filed:	unknown	Examiner: Kyle Choi
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Protest Under 37 CFR 1.291(a)

Assistant Commissioner for Patents

Attention: Office of Petitions

Crystal Park 1, Room 520

Washington, D.C. 20231

I hereby certify that this document is being sent via
First Class U. S. mail addressed to: Assistant
Commissioner for Patents, Washington, D.C. 20231
on this 30 day of July, 2001.

Kepner Tregoe
(Name)

Dear Sir:

The following protest is being filed with the belief that the Applicant of the above-referenced US non-provisional application is attempting to obtain rights for claims that are anticipated in light of the enclosed references.

In Kepner-Tregoe, Inc. v. Executive Development, Inc., Civ. No. 97-CV-3473, (D.N.J.), the court held on December 13, 1999, that Executive Development's materials did not infringe copyrights of Kepner-Tregoe. The court records evidence that the references enclosed in this protest were in possession of Kepner-Tregoe, who it is believed is an Assignee of the US application being protested. See Kepner-Tregoe, Inc. v. Executive Development, Inc., Civ. No. 97-CV-3473 (D.N.J. 1999), p. 4 of App. 0006. For this reason, these references should have been disclosed under 37 CFR 1.56. 37 CFR 1.56 states, in part, "Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section." It is not known whether Applicant or Applicant's attorney has put these references into the possession of the Examiner for consideration and review. However, in view of

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PCT application PCT/US99/15049, Protestor submits the enclosed references to ensure that no patent is granted for material that was publicly known before the date of invention by the Applicant.

Protestor submits that the subject matter of Applicant's claims was publicly known or used by others in this country before the invention thereof by the Applicant for patent, and is therefore barred under 35 U.S.C. § 102(a), in light of a software program entitled "Decision Focus Software," copyrighted in 1995 by Executive Development, Inc. The attached excerpts from the "3M Stemwinder," published on May 10, 1995, and the "1996 ASTD Buyer's Guide & Consultant Directory," published in November 1995, evidence that the "Decision Focus Software" was in the public prior to Applicant's "invention date."

Attached herewith, is a User's Manual for the "Decision Focus Software," along with selected screen shots from the software. Protestor would like the Examiner to note the screen shots (Figures 1-24) which clearly show elements that would anticipate or make obvious the subject matter of Applicant's claims. The following is an explanation of terms and elements that the Applicant is claiming that Protestor submits are anticipated by the submitted references.

It is Protestor's belief that the above-identified application includes claims 1-3 equivalent to claims 1-3 in published PCT application PCT/US99/15049, published on January 13, 2000. It is this belief which forms the basis for Protestor's assertion that the enclosed publication will make the claims unpatentable.

For the Examiner's convenience, Protestor has printed the subject claims in bold. The text which follows each element of the claim, permits one or more basis why each individual phrase of the claim is anticipated or rendered obvious in view of prior art.

PCT Application Claim 1

In the PCT application, Applicant set forth a first claim which read:

A method of gathering, processing, storing, and displaying information regarding a complex business situation, comprising the steps of:

Protestor submits that "Decision Focus Software" involves a method of gathering, processing, storing, and displaying information regarding a complex business situation. See Screen shot Figures and "Decision Focus Software Version 1.0" User's Guide p.1.

providing a graphical user interface

Definition: Graphical User Interface (GUI)

Defined as a program interface that takes advantage of the computer's graphics capabilities to make the program easier to use.

Decision Focus Software uses the computer's graphics capabilities to make the program easy to use when entering data concerning 4 types of complex business situations: Situations, Problems, Decisions, and Preventing Problems. It does not have a "command line" interface (the predecessor to GUI). It uses the Microsoft Windows API to display and input data concerning the complex situation graphically according to the Windows™ GUI standards. See Screen shot Figures.

for entering data concerning said complex business situation

A set of screen sequences allows entry of specific aspects of such a situation to generate a conclusion, solution, or action list. A situation appraisal sequence (Figure 1, "Decision Focus Software" User's Guide, p. 12) displayed in Figure 1 as a Situation Analysis sequence, allows entry of concerns stemming from the situation to prioritize such concerns. A problem analysis sequence (Figures 4-8 "Decision Focus Software" User's Guide p. 17-24) allows for the entry of data surrounding the problem in a stepwise manner and for entry of possible causes of a problem, and refining the causes to determine a true cause. A decision analysis sequence (Figure 13-14, "Decision Focus Software" User's Guide, p.27-32) allows entry of the decision statement, criteria, alternatives and risks concerning a decision. A problem prevention worksheet (Figure 20-21, "Decision Focus Software" User's Guide, p. 33-35) allows the entry and analysis of a plan and planning steps to assure that a minimum of problems will occur during implementation.

refining said data in a predetermined, stepwise manner through user interaction with said graphical user interface;

See Figure 2 , "Decision Focus Software" User's Guide, p. 12-13, Figures 9-12, "Decision Focus Software" User's Guide p. 21-24, Figures 15-18, "Decision Focus Software" User's Guide, p. 29-32, and Figure 22, "Decision Focus Software" User's Guide p.34-35. These Screen shots show how a user can refine the data entered in the situation appraisal step, the problem analysis step, the decision analysis step and the problem prevention step.

generating through said stepwise manner and said graphical user interface, a list of effective actions for addressing said complex business situation; and

See Figure 3, "Decision Focus Software" User's Guide p. 15, See boxes 6a and 6b of Figure 4, "Decision Focus Software" User's Guide, p. 25, and Figures 24-25, "Decision Focus Software" User's Guide p. 36-37. These Screen shots as well as the explanations in the "Decision Focus Software" User's Guide, generate a list of effective actions for addressing the complex business situation.

storing said data in an indexed

Definition: Indexed File

From An Introduction to Database Systems, C. J. Date, 1982, p. 38

"The purpose of an index is to provide an access path to the file it is indexing – that is, a way of getting to the records in that indexed file."

“An index is a file in which each entry (record) consists of a data value together with one or more pointers. The data value is a value for some field of the indexed file (the indexed field), and the pointers identify records in the indexed file having that value for that field. An index can be used in two ways. First, it can be used for sequential access to the indexed field. (In other words, it imposes an ordering on that indexed file.) Second, it can also be used for direct access to individual records in the indexed file on the basis of a given value for that same field.”

Decision Focus Software uses indexed files to access the user's data. It does this at two levels. At the highest level, the software uses the Microsoft Windows API (Application Programming Interface) indexed file system to access a pointer to the data stored in individual files. The software also uses an index that is imbedded in the machine readable code to access each record stored in each file. The index along with the imbedded procedures and functions permit the data to be stored, queried and retrieved as needed by the software. The data is then retrieved and displayed in the graphical user interface.

and normalized form

Definition: Normalization

From An Introduction to Database Systems, C. J. Date, 1982, p. 86

“At this point we introduce the idea of normalization. All relations in a relational database are required to satisfy the following condition.

- Every value in the relation – i.e., each attribute value in each tuple – is atomic (i.e. nondecomposable so far as the system is concerned).

To put it another way, at every row-and-column position in the table there always exists precisely one value, never a set of values. (We allow the possibility of null values – i.e., special values representing “unknown” or “inapplicable”, as in the case of “hours worked” for an employee on vacation.) A relation satisfying the foregoing condition is said to be normalized.”

Decision Focus Software data is stored in a normalized form. At every row-and-column position in each table generated by the Decision Focus software there exists precisely one value.

in a knowledge base

Definition: Database

From An Introduction to Database Systems, C. J. Date, 1982, p. 4

“... nothing more than a computer-based recordkeeping system; that is, a system whose overall purpose is to record and maintain information.”

Definition: Knowledge Base

From The American Heritage® Dictionary of the English Language: 4th Edition. 2000.

“NOUN: 1. *Computer Science* The part of an expert system that contains the facts and rules needed to solve problems. 2. A collection of facts and rules for problem solving.

From TechWeb Encyclopedia (www.techweb.com) “A database of rules about a subject used in AI applications. See expert system.”

Decision Focus Software stores data regarding complex business situations on a computer and maintains that information. Embedded in the program are procedures, functions and rules designed for storing, querying and retrieving information that the user supplies. The software together with the user’s data makes up the “knowledge base”. The software uses a graphical user interface to guide the user through a step by step process that gathers data, and evaluates and processes this data. The software assists the user in constructing a list of effective actions for addressing the complex business situation and stores that data for later retrieval.

adapted for structured query and retrieval in performing said steps of refining and generating.

Decision Focus Software stores its data in files that permits users to query and retrieve data from these files. Note that this claim states only “structured query” and does not specifically state the generally accepted and more specific database term “Structured Query Language (SQL)”. What is claimed then is the storing of data and then querying it in a structured manner. This is already done by the Decision Focus Software through optimized imbedded procedures and functions. Furthermore, the step of moving from storing and retrieving data in a structured manner to using one of the many “Structured Query Languages” and associated Database Management Systems (DBMS’s) available in the marketplace is a logical and obvious next step.

PCT Application Claim 2

Claim 2 of the PCT application recites:

a computer program product comprising computer readable program code fixed on a computer readable medium operable to receive, process, store, and display information concerning a complex business situation comprising:

Protestor submits that the reference submitted as prior art is a software program, which is a computer program product. Protestor further submits that the software has computer readable code fixed on a computer readable medium in the form of a 3.5” floppy disc, which is enclosed. As discussed above, the “Decision Focus Software” processes displays and stores information concerning a complex business decision.

As for the rest of claim 2, Protestor submits that, as discussed above, the “Decision Focus Software” performs all of the functions recited in the claim. The software comprises computer readable code for performing each function.

PCT Application Claim 3

Claim 3 of the PCT application recites:

An apparatus for gathering, processing, storing, and displaying information concerning a complex business situation comprising:

Protestor submits that a computer running the enclosed “Decision Focus Software” would be an apparatus for gathering, processing, storing, and displaying information concerning a complex business situation.

Protestor submits that a computer running the “Decision Focus Software” would be an apparatus that anticipates every element of claim 3 of the PCT application. As discussed above, the “Decision Focus Software” performs all of the functions listed in claim 1, which are repeated in claim 3.

Protestor submits that the references disclose a computer program product, a method, and an apparatus using a graphical user interface for entering information concerning a complex business situation, refining such information in a stepwise manner through the interface, generating a list of effective actions for addressing such a business situation, and storing such information in a knowledge base adapted for future query and reporting use of such a complex business situations.

Network Version 1.0– How it differs from single user

Protestor also includes a version of the “Decision Focus Software, Network Version,” copyrighted in 1995, which has some added features to the “Decision Focus Software,” which is a Single User version. Protestor submits this reference with the belief that Applicant may have included various claims in the application having elements reciting multiple users. The following are some additions to the “Decision Focus Software”:

Setup / Installation – The Network version is designed to install on a server. It then contains a user installation program that installs the subset of library files needed to run the software from each user node. See “Decision Focus Software Network Version 1.0” User’s Guide, p. 7.

File Sharing – The Network version is designed to allow users to share files and notify them if more than one file is being modified at the same time. See “Decision Focus Software Network Version 1.0” User’s Guide, p. 11.

Concurrent Uses and Metering – The Network version allows customers to purchase “N” concurrent use licenses. It then keeps track of the number of license that are in use and if more than “N” copies are started the N+1 copy is not allowed and an error message is displayed explaining this. An additional “Maintenance Utility” is provided for updating and modifying the configured number of licenses with direction by EDI.

Version 1.0 vs Version 4.0

Decision Focus Software, version 1.0, Single-User Version, was released to the marketplace in May, 1995. The Network Version, 1.0, was released in November, 1995. Decision Focus Software, version 4.0, both Single-User and Network Version were released in September 1998, and introduced the following enhanced features: Native Windows 95 libraries (no longer Win 3.1), Long Filenames, Enhanced “Print Preview,” Enhanced Printer driver support, Reordering DA Musts or Wants also reorders associated Info Pts and GoNo data, and “Tool Tips” for various buttons.

User’s Guides

User’s Guides were created for both the Single-User Version and Network Version and for both 1.0 and 4.0 versions. The User’s Guides were released to the marketplace concurrently with the Software.

In conclusion, Protestor submits that the enclosed references, along with the above explanation, anticipate or make obvious the subject matter claimed by Applicant. Any inquiries should be directed to the undersigned.

Respectfully submitted,

DORSEY & WHITNEY LLP

Date: July 23, 2001

By: James H. Ackley
James H. Ackley (Reg. No. 45,695)
Pillsbury Center South
220 South Sixth Street
Minneapolis, MN 55402
(612) 340-6381

STATE OF MINNESOTA)
) ss
COUNTY OF HENNEPIN)

AFFIDAVIT OF SERVICE

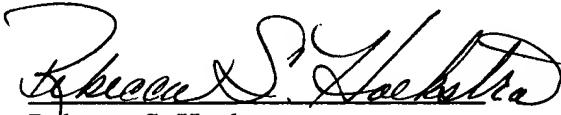
REBECCA S. HOEKSTRA, being first duly sworn, on oath deposes and says that
on July 23, 2001, she did deposit in the United States mail an envelope properly sealed and with
postage prepaid thereon, addressed to:

Theodore Miller, Esq.
Kepner-Tregoe, Inc.

P.O. Box 704
Princeton, NJ 08542

the last known address of said addressee(s), in which envelope she had first placed a true and
correct copy of the attached:

Communication regarding Protest filed under 37 CFR 1.291(a)
Protest filed under 37 CFR 1.291(a)
PTO-1449 Form – submitted in duplicate
Copy of each reference listed on the PTO-1449 form
Certificate of Service of the Protest upon Applicant in accordance with 37 CFR 1.248
PCT application PCT/US99/15049


Rebecca S. Hoekstra

Subscribed and sworn to before me

on July 23, 2001.



Notary Public



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